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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/098,534

03/18/2002

Takeo Tanaami

020349

6234

38834

7590

03/26/2004

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EXAMINER

EVANS, FANNIE L

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/098,534	Applicant(s) TANAAMI ET AL.	
	Examiner F. L. Evans	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9 and 12-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 2-4, 6, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 2, 6, 10 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is incomplete in that it depends from cancelled claim 1. Cancellation of claim 2 is required.

The if clause/statement in claim 6 renders the claim indefinite in that the claim fails to positively step forth the structure for which protection is sought. The structure which goes to make up the biochip reader must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

The lack of an antecedent for "the...objective lens" in line 7 of claim 10; "said biochip" in lines 5, 8, 9 and 11 of claim 11; and "the image-forming optical system" in line 7 of claim 11 renders claims 10, 11 and any claim dependent therefrom indefinite.

The text in the parentheses in lines 5, 6 and 8 of claim 10 and the extensive use of alternatives in lines 7 and 8 of claim 10 renders the claim indefinite.

In line 2 of claim 11, it is not clear what "its" refers to. Clarification or correction is required.

Regarding claim 11, the phrase "such as" in line 2 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art in applicant's Fig. 3 in view of Ramm et al (US 6,345,115 B1), of record.

The prior art biochip reader in applicant's Fig. 3 comprises a barrier filter (24) which acts to transmit fluorescence from a sample surface but to attenuate excitation light reflected from the sample surface. The incident angle of the reflected excitation light on the barrier filter is not specified.

Ramm et al disclose an imaging system capable of reading microchips. The imaging system comprises a barrier filter. See the paragraph bridging columns 13 and 14. In lines 2-7 of column 14, Ramm et al teach that the light incident on the barrier filter is 0 degrees.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to arrange the barrier filter of the prior art biochip reader of Fig. 3 at 0 degrees with respect to the incident light because of the teaching in lines 4-7 of column 14 of Ramm et al.

***Allowable Subject Matter***

Claim 7 is allowed over the prior art of record.

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and

any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed on December 30, 2003 have been fully considered but they are not persuasive with respect to claims 3, 4 and 10. On page 8 of the amendment, applicant discusses the significance of the  $\pm 5^\circ$ . Applicant's attention is directed to the fact that the claims specify " $\pm 5^\circ$  or less".  $0^\circ$  is less than  $\pm 5^\circ$ .

Applicant's arguments with respect to the rejection of claim 11 under 35 U.S.C. § 103 has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made under 35 U.S.C. § 112, second paragraph, with respect to claims 2, 6, 10 and 11.

### ***Fax/Telephone Numbers***

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for Technology Center 2800 is (703) 872-9306 for regular and After Final communications.

If applicant wishes to send a fax containing a Proposed Amendment for discussion during either a personal interview or a telephone interview then the fax should:

- 1) Contain either the statement "**DRAFT**" or "**PROPOSED AMENDMENT**" on the Fax Cover Sheet; and
- 2) Should be unsigned by the attorney or agent.

This will ensure that the amendment will not be entered into the application and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font, can be reached on (571) 272-2415. The TC Receptionist's telephone number is (571) 272-1562.

Any other inquiry of a technical nature, and all inquiries of a general nature including those relating to the status of an application should be directed to TC 2800 Customer Service

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Office whose telephone number is (571) 272-1585.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**F. L. EVANS**  
**PRIMARY EXAMINER**  
**ART UNIT 2877**

file

March 20, 2004